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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/663,151
Filing Date: September 15, 2000
Appellant(s): SWEARINGEN ET AL.

Lawrence R. Youst (Reg. No. 38, 795)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on August 14, 2008 appealing from the Office action mailed March 19, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

9(a) Claims 67-114 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 67-114 are drawn to "a computer readable medium having a sequence of instructions, a system and a method for enabling a trade in a user selected user preferred security, the method comprising: identifying user preferred securities from a plurality of securities based upon at least two user specific criteria including at least one criterion related to pricing; generating a graph in which each of the user preferred securities is represented and graphically differentiated from each of the other user preferred securities based upon the values of at least three user specific parameters associated with each of the user preferred securities; receiving a user selection of one of the user preferred securities represented on the graph; associating order parameters with the user selected user preferred security; and sending an order to execute a trade in, the user selected user preferred security according to the order parameters". As such the claimed invention is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea, natural phenomenon, or law of nature) and is not directed to a practical application of such judicial exception because the claims do not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result.

The Court of Appeals for the Federal Circuit issued opinions in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999).

These decisions explained that, to be eligible for patent protection, the claimed invention as a whole must accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601 02. To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways: (a) The claimed invention “transforms” an article or physical object to a different state or thing. (b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107. The computer readable medium claims 67-82 and the system claims 83-98 of the claimed invention is inoperative and therefore lacks utility as discussed below.

For an invention to produce a “concrete” result, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable. The steps of the method are not described in sufficient specific detail to guarantee that results will be concrete. For instance one of the intermediate steps includes receiving a user selection of one of the user preferred securities represented on the graph. However it is not clear how a certain graph will result in the same selection of securities by a user. Since there is no guarantee that the user selection will be identical for all iterations of the method, this step does not necessarily lead to concrete results.

9(b) Claims 67-82 of the disclosed invention is inoperative and therefore lacks utility. Claims 67-82 are drawn to “a computer readable medium having a sequence of instructions which, when executed by a processing entity, effectuates a trade in a user selected user preferred security, the computer readable medium comprising: a code segment for identifying user preferred securities from a plurality of securities based upon at least two user specific criteria including at least one criterion related to pricing; a code segment for generating a graph in which each of the user preferred securities is represented and graphically differentiated from each of the other user preferred securities based upon the values of at least three user specific parameters associated with each of the user preferred securities; a code segment for receiving a user selection of one of the user preferred securities represented on the graph; a code segment for associating order parameters with the user selected user preferred security; and a code segment for sending an order to execute a trade in the user selected user preferred security according to the order parameters”. The computer readable medium is interpreted broadly to include an intangible medium. Claims 67-82 merely recite elements of a computer readable medium (“code segments” correspond to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility. Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor). Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed.

Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

9(c) Similarly Claims 83-98 of the disclosed invention is inoperative and therefore lacks utility. Claims 83-98 are drawn to “system for enabling a trade in a user selected user preferred security, the system comprising: means for identifying user preferred securities from a plurality of securities based upon at least two user specific criteria including at least one criterion related to pricing; means for generating a graph in which each of the user preferred securities is represented and graphically differentiated from each of the other user preferred securities based upon the values of at least three user specific parameters associated with each of the user preferred securities; means for receiving a user selection of one of the user preferred securities represented on the graph; means for associating order parameters with the user selected user preferred security; and means for sending an order to execute a trade in the user selected user preferred security according to the order parameters”. Claims 67-82 merely recite elements of a system (“means for” are broadly interpreted to correspond to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility. Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor). Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other

functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

9(d) Claims 99-114 are drawn to “a method for enabling a trade in a user selected user preferred security, the method comprising: identifying user preferred securities from a plurality of securities based upon at least two user specific criteria including at least one criterion related to pricing; generating a graph in which each of the user preferred securities is represented and graphically differentiated from each of the other user preferred securities based upon the values of at least three user specific parameters associated with each of the user preferred securities; receiving a user selection of one of the user preferred securities represented on the graph; associating order parameters with the user selected user preferred security; and sending an order to execute a trade in, the user selected user preferred security according to the order parameters”. It is not clear as to which statutory class the claimed invention of claims 99-114 belongs. The claimed invention does not fall in the process category for the following reason. The Supreme Court has recognized only two instances in which such a method may qualify as a section 101 process: when the process ‘either [1] was tied to a particular apparatus or [2] operated to change materials to a ‘different state or thing.’” In *Diehr*, the Supreme Court confirmed that a process claim reciting an algorithm could state statutory subject matter if it: (1) is tied to a machine or (2) creates or involves a composition of matter or manufacture.¹² 450 U.S. at 184. There, in the context of a process claim for curing rubber that recited an algorithm, the Court concluded that “[t]ransformation and reduction of an article ‘to a different state or thing’ is the clue to the patentability of a process claim that does not include particular machines.” Id. (quoting *Benson*, 409 U.S. at 70);¹³ see also *In re Schrader*, 22 F.3d 290, 295 (Fed. Cir. 1994) (holding when a

claim does not invoke a machine, “§ 101 requires some kind of transformation or reduction of subject matter”). Thus, a claim that involves both a mental process and one of the other categories of statutory subject matter (i.e., a machine, manufacture, or composition) may be patentable under § 101. However, mental processes—or processes of human thinking—standing alone are not patentable even if they have practical application. The Supreme Court has stated that “[p]henomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.” *Benson*, 409 U.S. at 67 (emphasis added). In *Flook* the patentee argued that his claims did not seek to patent an abstract idea (an algorithm) because they were limited to a practical application of that idea—updating “alarm limits” for catalytic chemical conversion of hydrocarbons. 437 U.S. at 586, 589-90. The Court rejected the notion that mere recitation of a practical application of an abstract idea makes it patentable, concluding that “[a] competent draftsman could attach some form of post-solution activity to almost any mathematical formula.” Id. at 590. Since all other features of the process were well-known, including “the use of computers for ‘automatic monitoring-alarmed,’” the Court construed the application as “simply provid[ing] a new and presumably better method for calculating alarm limit values.” Id. at 594-95. The 14 See AT&T, 172 F.3d at 1355, 1358 (holding patentable “a process that uses the Boolean principle in order to determine the value of the PIC indicator” and that “require[d] the use of switches and computers”); *State Street Bank*, 149 F.3d at 1373 (“[W]e hold that the transformation of data . . . by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm.” (emphases added)); *Alappat*, 33 F.3d at 1544 (“This is not a disembodied mathematical concept which may be characterized as an ‘abstract

idea,' but rather a specific machine to produce a useful, concrete, and tangible result.'" (emphases added)); *Arrhythmia Research Tech., Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1058-59 (Fed. Cir. 1992) (holding patentable a method for analyzing electrocardiograph signals for the detection of a specific heart condition that used "electronic equipment programmed to perform mathematical computation"). Court held the application unpatentable because "if a claim [as a whole] is directed essentially to a method of calculating, using a mathematical formula, even if the solution is for a specific purpose, the claimed method is nonstatutory." 437 U.S. at 595 (quoting *In re Richman*, 563 F.2d 1026, 1030 (CCPA 1977)). Following the lead of the Supreme Court, this court and our predecessor court have refused to find processes patentable when they merely claimed a mental process standing alone and untied to another category of statutory subject matter even when a practical application was claimed. In *Schrader* we held unpatentable a "method constitut[ing] a novel way of conducting auctions" by allowing competitive bidding on a plurality of related items. 22 F.3d at 291. In doing so, we rejected the patentee's argument that the process used a machine. Two of the alleged machines—a "display" in the front of the auction room and "a closed-circuit television system" for bidders in different cities—were not claimed by the patent, and the third—a "record" in which bids could be entered—could be "a piece of paper or a chalkboard." Id. at 293-94. We therefore concluded that the patent impermissibly claimed unpatentable subject matter. Similarly, in *In re Warmerdam*, 33 F.3d 1354 (Fed. Cir. 1994), we held unpatentable a process for controlling objects so as to avoid collisions because the key steps of "locating a medial axis" and "creating a bubble hierarchy" described "nothing more than the manipulation of basic mathematical constructs, the paradigmatic 'abstract idea.'" Id. at 1360. A machine was not required, id. at 1358, nor was there any indication that the

process operated on a manufacture or composition of matter. Decisions of our predecessor court are in accord. *In re Meyer*, 688 F.2d 789, 796 (CCPA 1982), held that “a mental process that a neurologist should follow” was not patentable because it was “not limited to any otherwise statutory process, machine, manufacture, or composition of matter.” *Id.* at 795. Similarly, *In re Maucorps*, 609 F.2d 481 (CCPA 1979), held that an invention “[u]ltimately . . . directed toward optimizing the organization of sales representatives in a business” was unpatentable. *Id.* at 482, 486. See also *Alappat*, 33 F.3d at 1541 (“*Maucorps* dealt with a business method for deciding how salesmen should best handle respective customers and Meyer involved a ‘system’ for aiding a neurologist in diagnosing patients. Clearly, neither of the alleged ‘inventions’ in those cases falls within any § 101 category.”). The steps of the method are untied to another category of statutory subject matter and hence the claimed invention does not qualify as a process under 35 U.S.C 101.

(10) Response to Argument

In response to Appellant’s assertion on page 18 of the Brief “Therefore, contrary to the Examiner’s assertions, the underlying process of claims 67 and 82, and claims depending therefrom, is repeatable and the result of effectuating a trade in a user selected user preferred security is reproducible”, the Examiner respectfully disagrees. Once user inputs of a user preferred security and at least two user specific criteria are received a graph is generated. The process is repeatable until this step. However after the generation of the graph the results are no longer repeatable because there is no guarantee that the user selection based the graph will be identical. Hence as stated in the rejection, it is not clear how a certain graph will result in the same selection of securities by a user. Since there is no guarantee that the user selection will be

identical for all iterations of the method, this step does not necessarily lead to concrete results. Hence the implementation of the steps of the process will not produce a useful, tangible and concrete result.

In response to Appellant's assertion on page 21 of the Brief "As in Alappat, the "means" clearly have support and structure as provided in the specification. This is indicated by example in Section 5 "Summary of the Claimed Subject Matter", supra, at pages 2-9, specifically pages 5-7. This is clear evidence that the presently claimed system properly satisfies the sixth paragraph of 35 U.S.C. § 112 and 35 U.S.C. § 101", Examiner respectfully disagrees. For a claim limitation to be interpreted using the 35 U.S.C. 112, sixth paragraph, if it must meet the following 3-prong analysis: (A) the claim limitations must use the phrase "means for " or "step for;" (B) the "means for " or "step for " must be modified by functional language; and (C) the phrase "means for " or "step for " must not be modified by sufficient structure, material, or acts for achieving the specified function. The system claims do not meet the third of the 3-prong analysis. The means for is modified by sufficient structure, material, or acts for achieving the specified function. For instance claim 83 recites "means for generating a graph in which each of the user preferred securities is represented and graphically differentiated from each of the other user preferred securities based upon the values of at least three user specific parameters associated with each of the user preferred securities". Clearly the means for generating a graph is modified by a lot of structure, material, or acts for achieving the function of generating. Hence the system claims 83-98 do not satisfy the sixth paragraph of 35 U.S.C. § 112.

In response to Appellant's assertion on page 27 of the Brief "Proper construction under the USPTO's "broadest reasonable interpretation" standard defines the claim 99 method as

requiring the code segments on computer readable medium (article of manufacture) and the system (machine) embodying the code segments on computer readable medium. See Specification at page 6, lines 8-16, for example.”, Examiner respectfully disagrees. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As discussed in the rejection of method claims 99-114, the steps of the method are untied to another category of statutory subject matter and hence the claimed method does not qualify as a process under 35 U.S.C 101.

Appellant’s other arguments have been fully considered but they are not persuasive.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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October 22, 2008

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